

### **REMARKS/ARGUMENTS**

This Amendment is responsive to the Office Action dated December 18, 2006. Claims 1-5 and 9-18 were pending in the application. In the Office Action, claims 1-5 and 9-18 were rejected. In this Amendment, claims 1 and 18 are amended and claims 30-33 are added. Claims 1-5, 9-18 and 30-35 remain for consideration.

Applicant submits that claims 1-5, 9-18 and 30-33 are in condition for allowance and requests withdrawal of the rejections in light of the following remarks.

#### **A. Claim Rejections Under 35 U.S.C. §112, first paragraph**

Claims 1-5 and 9-17 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

Specifically, the Examiner stated that the specification as originally filed does not provide support for (1) the limitation the surface of the substrate comprises a coated laminate, (2) that the laminate or breathable film has a thickness of 2 mils and (3) the film or coated laminate has a minimum moisture vapor transmission rate of greater than 20 g/m<sup>2</sup>/day but less than 500 g/m<sup>2</sup>/day.

Applicant respectfully rebuts the above statements.

(1) The limitation regarding the surface of the substrate comprises a coated laminate can be found on page 9 paragraph [0043] of the specification. In this paragraph, the specification teaches that the substrate may be coated in a number of ways, one of which is lamination pressing.

(2) The limitation regarding the thickness of the breathable film can be found on page 9, paragraph [0040]. Here, the specification teaches that the thickness of the film is in a range of

about 0.5 to about 10 mils, with the preferred range being about 1 to about 3 mils. Two mils fall within this range.

(3) The limitation regarding the minimum moisture vapor transmission rate of greater than  $20 \text{ g/m}^2/\text{day}$  but less than  $500 \text{ g/m}^2/\text{day}$  can be found on page 3, paragraph [0010]. In order for a material to be “breathable,” it must have a minimum moisture vapor transmission rate of about  $6.7 \text{ g}/100 \text{ sq.in}/24 \text{ hours}$  or greater which is equivalent to  $1.039 \text{ g/m}^2/\text{day}$  or greater. Accordingly, the breathability range for the claimed film is  $20 \text{ g/m}^2/\text{day}$  but less than  $500 \text{ g/m}^2/\text{day}$  which is well within the breathability range taught in the specification.

**B. Claim Rejections Under 35 U.S.C. § 103(a)**

1. Claims 1-2, 4-5, 10, 12-14, 17 and 18 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 6,645,336 to Albertone et al. (hereafter “Albertone”) in view of WO 9637668.

2. Claim 3 was rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 6,645,336 to Albertone et al. (hereafter “Albertone”) in view of WO 9637668 as set forth above, and further in view of U.S. Patent No. 4,511,619 to Kuhnel et al. (hereafter “Kuhnel”).

3. Claims 11 and 15 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 6,645,336 to Albertone et al. (hereafter “Albertone”) in view of WO 9637668 as set forth above, and further in view of U.S. Patent No. 6,300,257 to Kirchberger et al. (hereafter “Kirchberger”).

4. Claim 16 was rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 6,645,336 to Albertone et al. (hereafter “Albertone”) in view of WO 9637668 as set forth above, and further in view of EP 1,245,620.

Applicant submits that independent claims 1 and 18 are patentable over Albertone, Kuhnel, Kirchberger, WO 9637668 and EP 1,245,620 -- either taken alone or in combination.

Applicant's invention as recited in the independent claims (Claims 1 and 18) are directed toward a non-asphaltic underlayment. For example, independent claim 1 specifies that the underlayment comprises a glass fiber-based substrate in which at least one surface thereof comprises a coatable laminate or a breathable thermoplastic film having a minimum moisture vapor transmission rate of greater than 20 g/m<sup>2</sup>/day but less than 500 g/m<sup>2</sup>/day. Claim 1 further specifies that an adhesion improvement component is added to the non-asphaltic underlayment to improve adhesion between the breathable thermoplastic film or coated laminate and the glass fiber-based substrate. (See paragraphs [0034]-[0037]).

Independent claim 18 contains similar limitations.

Albertone, Kuhnel, Kirchberger, WO 9637668 and EP 1,245,620 do not disclose an adhesion improvement component that is added to the non-asphaltic underlayment so that adhesion between the breathable thermoplastic film or coated laminate and the glass fiber-based substrate is improved.

Examiner admits that Albertone "does not specifically teach that the substrate is a glass fiber fabric." To overcome this deficiency, Examiner relies on WO '668 for the teaching that mineral fibers are equivalent to organic fibers. WO '668, however, merely mentions that the support layer may be a mineral fiber but does not teach or suggest to one skilled in the art how to adhere a breathable thermoplastic film to the glass fiber as claimed in claim 1 of the application.

Kuhnel, Kirchberger and EP '620 also do not teach or suggest to one skilled in the art how to adhere a breathable thermoplastic film to the glass fiber as claimed in claim 1 of the application.

Since Albertone, Kuhnel, Kirchberger, WO 9637668 and EP 1,245,620 do not disclose an adhesion improvement component that is added to the non-asphaltic underlayment to improve adhesion between the breathable thermoplastic film or coated laminate and the glass fiber-based substrate; Applicant believes that independent claims 1 and 18 are patentable over Albertone, Kuhnel, Kirchberger, WO 9637668 and EP 1,245,620-- either taken alone or in combination -- on at least this basis.

Additionally, Applicant respectfully disagrees with Examiner that it would have been obvious to one of ordinary skill in the art to have selected the desired MVTR through a process of routine experimentation. The optimal MVTR range chosen for the claimed device was based on the preferred materials used for the underlayment and choosing these materials was a rigorous selection process. Finding the MVTR for these materials was not done with routine experimentation as suggested by the Examiner. As such, Applicant requests that Examiner withdraw this argument from the above rejections.

Claims 2-5, 9-18 and 30-32 depend on claim 1. Since claim 1 is believed to be patentable over Albertone, Kuhnel, Kirchberger, WO 9637668 and EP 1,245,620, claims 2-5, 9-18 and 30-32 are believed to be patentable over Albertone, Kuhnel, Kirchberger, WO 9637668 and EP 1,245,620 on the basis of their dependency on claim 1.

Claims 33-35 depend on claim 18. Since claim 18 is believed to be patentable over Albertone, Kuhnel, Kirchberger, WO 9637668 and EP 1,245,620, claims 33-35 are believed to

be patentable over Albertone, Kuhnel, Kirchberger, WO 9637668 and EP 1,245,620 on the basis of their dependency on claim 18.

### **CONCLUSION**

In view of the aforementioned remarks and amendments, the Applicants believe that each of the pending claims is in condition for allowance. If, upon receipt and review of this amendment, the Examiner believes that the present application is not in condition for allowance and that changes can be suggested which would place the claims in allowable form, the Examiner is respectfully requested to contact Applicants' undersigned counsel at the number provided below.

Please charge any additional fees that may be due, including the one month extension fee, and additional claim fees, or credit any overpayment of same, to Deposit Account No. 03-1250 (Docket No. 12080001.000023).

Respectfully submitted,

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